

PATENT APPLICATION

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re application of

Docket No: Q80457

Hiroyuki IIDA

Appln. No.: 10/802,868

Group Art Unit: 2627

Confirmation No.: 5449
JOSEPH

Examiner: KLIMOWICZ, WILLIAM

Filed: March 18, 2004

For: SLIDING MEMBER

APPEAL BRIEF UNDER 37 C.F.R. § 41.37

MAIL STOP APPEAL BRIEF - PATENTS

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In accordance with the provisions of 37 C.F.R. § 41.37, Appellant submits the following:

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I. REAL PARTY IN INTEREST

The real party in interest is Nitto Denko Corporation by virtue of the Assignment submitted and recorded in the present application.

II. RELATED APPEALS AND INTERFERENCES

Appellant, Appellant's legal representatives, and the Assignee of this application are not aware of any other appeals or interferences that will directly affect, be affected by, or have a bearing on the Board's decision in the pending appeal.

III. STATUS OF CLAIMS

Claims 1, 2, 4 and 6-11 are pending in the application.

Claims 1, 2, 4 and 6-11 have been rejected, and are the subject of this appeal.

Claims 3 and 5 have been canceled.

A copy of pending claims 1, 2, 4 and 6-11 is set forth in the attached Claims Appendix.

IV. STATUS OF AMENDMENTS

The claims stand as presented in the June 11, 2009 Amendment under 37 C.F.R. §1.111.

There are no outstanding amendments to the claims or to the specification in the present application.

V. SUMMARY OF THE CLAIMED SUBJECT MATTER

Claim 1 is the only independent claim on appeal.

Claim 1 is directed to a sliding member comprising a slidable substrate, a pressure-sensitive adhesive layer provided on one side thereof, and a barrier layer. *See* page 2, lines 6-9. The slidable substrate is a porous form having a porosity of 20-70% and comprises an ultrahigh molecular weight polyethylene. *See* page 3, lines 10-11 and lines 14-15, and page 7, lines 3-4. The barrier layer is provided between the slidable substrate and the pressure-sensitive adhesive layer. *See* page 2, lines 8-9.

VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

An issue on appeal is whether the Examiner improperly finally rejected claims 1, 2, 4, 6, 7 and 11 under 35 U.S.C. § 103(a) as allegedly being unpatentable over JP 08-031128 to Nagai (JP '128) in view of JP 2002-166401 to Tsubouchi (JP '401).

An issue on appeal is whether the Examiner improperly finally rejected claims 8-10 under 35 U.S.C. § 103(a) as allegedly being unpatentable over JP '128 in view of JP '401, and further in view of JP 08-034959 A to Nakanishi (JP '959).

VII. ARGUMENT

A. The rejection of claims 1, 2, 4, 6, 7 and 11 under 35 U.S.C. § 103(a) as allegedly being unpatentable over JP 08-031128 to Nagai (JP ‘128) in view of JP 2002-166401 to Tsubouchi (JP ‘401) should be reversed because a *prima facie* case of obviousness has not been established.

Claim 1 is directed to a sliding member comprising a slidable substrate, a pressure-sensitive adhesive layer provided on one side thereof, and a barrier layer, wherein the slidable substrate is a porous form having a porosity of 20-70% and comprises an ultrahigh molecular weight polyethylene, and wherein the barrier layer is provided between the slidable substrate and the pressure-sensitive adhesive layer.

A *prima facie* showing of obviousness requires (1) a suggestion or motivation in the references or in the knowledge of one of ordinary skill in the art, to modify the references or to combine reference teachings; (2) a reasonable expectation of success; and (3) a teaching or suggestion of all claimed limitations.

It is respectfully submitted that JP ‘128, either alone or in view of JP ‘401, does not disclose, teach or suggest every element of claim 1.

The sliding member according to the present application (for example, as shown in FIG. 1 of the present application, reproduced below) comprises a slidable substrate 1, a pressure-sensitive adhesive layer 2 provided on one side of the slidable substrate, and a barrier layer 3 that is provided between the slidable substrate and the pressure-sensitive adhesive layer. The slidable

substrate 1 is a porous form having a porosity of 20-70%. The pressure-sensitive adhesive layer 2 can be provided with a separator 4.

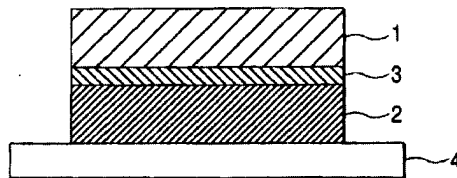


FIG. 1

The Examiner asserts that the JP '128 discloses a laminate structure having all the features of the present invention, except for a barrier layer that is provided between the slidable substrate and the pressure-sensitive adhesive layer. The Examiner then takes the position that providing a barrier layer between the porous substrate and adhesive layers to prevent migration of adhesive into the porous substrate is well known in the art. To support his position, the Examiner cites JP '401 as assertedly disclosing a barrier layer (2) that is provided between a porous substrate (1) and an adhesive layer (3) to prevent an adhesive from infiltration into a surface of a porous substrate.

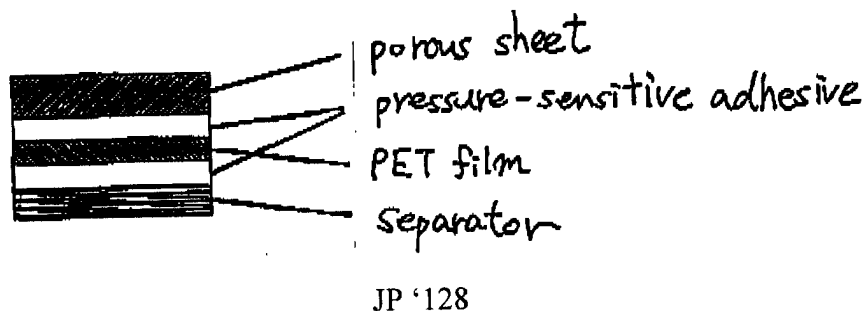
Appellants disagree with the Examiner's characterization of JP '128. JP '128 does not only fail to disclose the claimed barrier layer, the construction of the member for optical disk protection of JP '128 is clearly different from the claimed sliding member of the present application.

JP' 128 is directed to a method of forming an optical disk unit which does not generate errors at the time of writing and reading by reducing the friction between an optical disc and the

cartridge case to suppress the generation of worn powder and capturing the worn powder that is generated. See JP '128, paragraph [0001], English machine translation. A member for protecting the optical disc is obtained by sticking the porous sheet on one surface and a separator on the other surface to form a double coated tacky adhesive tape and blacking the tape to an annular shape. See Abstract.

JP '128 discloses, for example in Example 1 at paragraphs [0038] to [0039], a double-coated pressure-sensitive adhesive tape that is obtained by applying the pressure-sensitive adhesive to the both sides of the substrate (polyethylene terephthalate film) having a thickness of 25 μm . Then, the separator is attached to one side of the double-coated pressure-sensitive adhesive tape, and the porous sheet is attached to the other side of the double-coated pressure-sensitive adhesive tape, thereby obtaining the member for optical disk protection.

The resulting member for optical disk protection of JP '128 has the following structure.



Quite clearly, the laminate structure of the member for optical disk protection of JP '128 is different from the claimed sliding member of the present application.

Further, there is no suggestion or motivation in the references or in the knowledge of one of ordinary skill in the art, to modify JP '128 in view of the teaching of JP '401, in the manner suggested by the Examiner.

Regarding the secondary reference JP '401, the Examiner asserts that JP '401 discloses a barrier layer 2 that is provided between a porous substrate 1 and an adhesive layer 3, to prevent an adhesive from infiltration into a surface of a porous substrate. As such, it is the Examiner's position that JP '401 makes up for the noted deficiencies of JP '128.

Appellants respectfully disagree.

It is respectfully submitted that one of ordinary skill in the art would not be motivated to combine the references of JP '128 and JP '401 for at least the following reasons.

JP '401 is directed to a method for manufacturing a resin impregnation treated reinforced laminate material having high surface hardness (e.g., plywood). Even if JP '401 may teach a barrier layer provided between a porous substrate and an adhesive in order to prevent the adhesive (in solution form) from infiltration into the pores, such is not a concern with JP '128.

Specifically, JP '128 teaches that the adhesive is applied to the separator and dried, and then the porous sheet is stuck to the pressure sensitive adhesive. Since the adhesive of JP '128 is **dried** prior to being attached to the porous sheet, one of ordinary skill in the art would not be concerned with the adhesive infiltrating the pores of the sheet.

Thus, it is respectfully submitted that one of ordinary skill in the art would not be motivated to modify JP '128 to provide a barrier layer between the porous substrate and adhesive layers, as proposed by the Examiner based on the teachings of JP '128 and JP '401.

For at least the above reasons, Appellants submit that the Examiner has failed to establish a *prima facie* case of obviousness. Thus, claims 1, 2, 4 and 6-11 are patentable over JP '128, either alone or in view of JP '401.

B. The rejection of claims 8-10 under 35 U.S.C. § 103(a) as allegedly being unpatentable over JP '128 in view of JP '401, and further in view of JP 08-034959 A to Nakanishi (JP '959) should be reversed because a *prima facie* case of obviousness has not been established.

JP '959 is relied upon by the Examiner as assertedly disclosing the claimed material of the barrier layer. It is submitted that JP '959 does not cure the above discussed deficiencies of JP '128 and JP '401.

In addition, claims 8-10 depend from claim 1 and would therefore be patentable over the art for at least the reasons mentioned with respect to claim 1.

Conclusion

For at least the above reasons, Appellants respectfully submit that the obviousness rejections should be reversed.

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The USPTO is directed and authorized to charge the statutory fee (37 C.F.R. §41.37(a) and 1.17(c)) and all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,



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Date: April 1, 2010

CLAIMS APPENDIX

CLAIMS 1-2, 4 and 6-11 ON APPEAL:

1. A sliding member comprising a slidable substrate; a pressure-sensitive adhesive layer provided on one side thereof; and a barrier layer,

wherein the slidable substrate is a porous form having a porosity of 20-70% and comprises an ultrahigh molecular weight polyethylene; and

wherein the barrier layer is provided between the slidable substrate and the pressure-sensitive adhesive layer.

2. The sliding member as claimed in claim 1, wherein the slidable substrate has a coefficient of friction of 0.2 or lower.

4. The sliding member as claimed in claim 1, wherein the ultrahigh molecular weight polyethylene has a molecular weight of 500,000 or higher.

6. The sliding member as claimed in claim 1, wherein the barrier layer comprises a thermoplastic resin.

7. The sliding member as claimed in claim 6, wherein the thermoplastic resin has a melt viscosity of 5-500 kPa.s.

8. The sliding member as claimed in claim 7, wherein the thermoplastic resin is a crosslinked polyethylene.

9. The sliding member as claimed in claim 1, wherein the barrier layer has a thickness of 0.01-0.5 mm.

10. The sliding member as claimed in claim 1, wherein the barrier layer comprises polyethylene or polypropylene.

11. The sliding member as claimed in claim 1, wherein one side of the barrier layer is adjacent to one side of the pressure-sensitive adhesive layer and the other side of the barrier layer is adjacent to one side of the slidable substrate.

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EVIDENCE APPENDIX:

Pursuant to 37 C.F.R. § 41.37(c)(1)(ix), submitted herewith are copies of any evidence submitted pursuant to 37 C.F.R. §§ 1.130, 1.131, or 1.132 or any other evidence entered by the Examiner and relied upon by Appellant in the appeal.

None.

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RELATED PROCEEDINGS APPENDIX

Submitted herewith are copies of decisions rendered by a court or the Board in any proceeding identified about in Section II pursuant to 37 C.F.R. § 41.37(c)(1)(ii).

None.